# REMARKS/ARGUMENTS

The rejections presented in the Office Action dated August 15, 2005 (hereinafter Office Action) have been considered. Claims 1-50 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1-5, 8, 34, 46, and 47-49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,112,244 to Moore et al. (hereinafter *Moore*), and further in view of U.S. Publication No. 2002/0046236 to Morimoto et al. (hereinafter *Morimoto*). Applicant respectfully traverses the rejection. To establish a *prima facie* case of obviousness based on a combination of references, three basic criteria must be met, as is set forth in M.P.E.P., §2143:

> 1) There must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
> 2) There must be a reasonable expectation of success; and
> 3) The prior art references must teach or suggest all of the claim limitations.

All three criteria must be met to establish *prima facie* obviousness of a claim.

The Applicants respectfully submit that the claims as originally filed are not rendered obvious in view of the combination of *Moore* and *Morimoto*. However, in order to facilitate prosecution of the application, the Applicants present this response with amendment to clarify particular aspects of the claimed invention.

Applicant's independent Claims 1, 34, 46, 47, 48 , and 49 are directed to use of provisioning data that includes an application identifier corresponding to a network application hosted by a plurality of application servers. The provisioning data also includes an application server address of one of the plurality of applications servers that is associated with the application identifier. The Applicant respectfully submits that the combination of *Moore* and *Morimoto* fail to teach or suggest these features.

*Moore* describes a server that has a plurality of applications, each associated with an application identifier. However, the application identifiers in *Moore* are associated with codebooks, not with server addresses. The Office Action states that *Moore's* server

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inherently includes, along with the application identifiers, an application server address. The Applicant wishes to thank the Examiner for the attached reference to Computer Networking, A Top-Down Approach by J. Kurose (hereinafter *Kurose*) showing source and destination addresses in TCP/IP headers to illustrate this point. The Applicant agrees that, in some cases, it may be inferred that the application server in *Moore* sends its own address in network transactions. However, Applicant submits that these references fall short of teaching or suggesting placing an address of one of a plurality of application servers in provisioning data as set forth in the claims. The Applicant can provide at least two reasons for this.

First, the destination/source addresses in TCP/IP headers are not part of provisioning information. *Kurose* illustrates this in Figure 3.3, where the application data is clearly delineated from the header fields of a TCP segment, which is itself part of a TCP/IP packet. Thus, the codebooks and associated identifiers described in col. 1, lines 54-60 of *Moore* would be part of the application data of a TCP/IP packet, and the addresses in a TCP/IP header are separate from the application data. Therefore *Moore* does not teach or suggest including application server addresses *in provisioning data.*

Second, *Moore* does not teach or suggest any association between the application server address and the application identifier. *Moore* only states that the application identifiers are associated with codebooks, and nowhere teaches or suggests associating the identifiers with addresses. The possibility that a data packet may include both a source address in the TCP/IP headers along with an application identifier does not imply or suggest that the identifier is *associated* with the address. On the contrary, the delineation of TCP/IP headers and application data as illustrated in *Kurose* strongly suggests a *disassociation* between the addresses and application data.

*Moore* fails to teach associating application identifiers with an address of one of a plurality of application servers. Also, *Moore's* focus on associating application identifiers with codebooks fails to suggest associating the application identifiers with application server addresses. Therefore Applicant submits that *Moore* fails to teach or suggest placing an application identifier and an associated address of one of a plurality of application server in provisioning data. The Office Action did not rely on *Morimoto* as providing a remedy to

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these deficiencies of *Moore*, nor does *Morimoto* provide such a remedy. Therefore, the combination of *Moore* and *Morimoto* does not teach or suggest the each and every claim limitation independent Claims 1, 34, 46, 47, 48, and 49.

The Applicant further respectfully submits that there is a lack of motivation to combine *Moore* with *Morimoto*. The mere fact that references can be combined does not render the combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Even assuming *arguendo* that the references relied upon were individually known in the art, this is insufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The proffered motivations in the Office Action that one skilled in the art would have combined *Moore* with *Morimoto* "because it would improve the efficiency of the system" and "would increase the speed at which users could access information" are conclusory, and the level of skill in the art cannot be relied upon to provide the suggestion to combine references (see, *e.g.,. Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). More particularly, to establish prima facie obviousness, the proffered motivation must provide a clear and particular showing, supported by actual evidence, to combine the references. *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334, 63 U.S.P.Q.2d 1374, 1387 (Fed. Cir. 2002). It is respectfully submitted that the proffered motivation provided in the Office Action does not rise to the level of clear and particular actual evidence. For at least this additional reason, it is respectfully submitted that the requisite showing of motivation to combine *Moore* with *Morimoto* has not been met.

Dependent Claims 2-5 and 8 depend from independent Claim 1 and also stand rejected under 35 U.S.C. §103(a) based on the combination of *Moore* and *Morimoto*. While Applicant does not acquiesce with the particular rejections to these dependent claims, these rejections are now moot in view of the remarks made in connection with independent Claim 1. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from *Moore* and *Morimoto*. Therefore, dependent Claims 2-5 and 8 are also in condition for allowance.

Claims 6, 7 10-13, 14-16, 17, 18, 19-24, 26, 27, 30-33, 35-39, 41-42 and 44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore* and *Morimoto* as applied to claim 1, and further in view of U.S. Patent Publication No. 2002/0123335 to Luna et al. (hereinafter *Luna*). Claims 28, 29, and 45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore* and *Morimoto* as applied to claim 1, and further in view of U.S. Publication No. 2002/0068554 to Dusse (hereinafter *Dusse*). Claims 25 and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore* and *Morimoto* as applied to claim 1 and 34, and further in view of U.S. Patent No. 6,675,956 to Sigaud (hereinafter *Sigaud*). Claims 9, 43, and 50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore* and *Morimoto* as applied to claim 1, and further in view of U.S. Patent No. 6,643,690 to Duursma et al. (hereinafter *Duursma*).

For the rejections of Claims 6, 7, 9-33, 35-45, and 50 the Examiner relies on *Moore and Morimoto* as teaching the substance of the claims from which these claims ultimately dependent. In particular, Claims 6, 7, 9-33, depend directly or indirectly from independent Claim 1; Claims 35-45 depend directly or indirectly from independent Claim 34; and Claim 50 depends from Claim 49. For the rejections of Claims 6, 7 10-13, 14-16, 17, 18, 19-24, 26, 27, 30-33, 35-39, 41-42 and 44 the Office Action does not rely on *Luna* as providing a remedy to the deficiencies of *Moore* and *Morimoto* as it pertains to independents Claim 1 and 34, nor do *Moore* and *Morimoto* provide such a remedy. For the rejections of Claims 28, 29, and 45 the Office Action does not rely on *Dusse* as providing a remedy to the deficiencies of *Moore* and *Morimoto* as it pertains to independents Claim 1 and 34, nor do *Moore* and *Morimoto* provide such a remedy. For the rejections of Claims 25 and 40 the Office Action does not rely on *Siguad* as providing a remedy to the deficiencies of *Moore* and *Morimoto* as it pertains to independents Claim 1 and 34, nor do *Moore* and *Morimoto* provide such a remedy. For the rejections of Claims 9, 43, and 50 the Office Action does not rely on *Duursma* as providing a remedy to the deficiencies of *Moore* and *Morimoto* as it pertains to independents Claim 1, 34, and 49, nor do *Moore* and *Morimoto* provide such a remedy.

Thus, because the combinations of *Moore* and *Morimot* fail to teach at least the recitations of Claims 1, 34 and 49, the combinations of: *Moore, Morimoto, and Luna; Moore, Morimoto* and *Dusse*; *Moore, Morimoto* and *Siguad*; and *Moore, Morimoto* and

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*Duursma*; also fail to teach these recitations. Further, each of these combinations fails to suggest the invention set forth in Claim 1 and 34, as there is no reference to at least placing an application identifier and associated application server address into provisioning data, wherein application identifier corresponds to a network application hosted by a plurality of application servers, and the application server address corresponds to one of the plurality of applications servers. While other requisites of establishing prima facie obviousness may also be absent, the Applicants respectfully submit that the cited combination of references at least fails to teach or suggest all of the claim limitations. For at least this reason, Claims 6, 7, 9-33, 35-45, and 50 are not rendered obvious by the references relied upon in the Office Action, and withdrawal of the rejection is respectfully solicited.

Authorization is given to charge Deposit Account No. 50-3581 (NOKM.017PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned agent of record invites the Examiner to contact him at 952-892-2700 x12 to discuss any issues related to this case.

Respectfully submitted,

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